

REMARKS

I. Status of Claims

Claims 1-14 are pending. Claims 1, 3, 4, 8-11, 13, and 14 are amended herein. Applicants have amended claim 1 to incorporate the subject matter of now-cancelled claim 11. Support for the amendment to claim 1 may be found in original claim 11. Applicants have cancelled claim 11 without prejudice or disclaimer. Applicants have amended claims 3, 4, 8-10, 12 and 13 to modify the claims' dependencies. Applicants have also amended claims 1, 8, 9, 10 and 14 to address an informality, specifically, to change the spelling of "silicium" to "silicon." Therefore, no new matter has been added by these amendments, and claims 1-10 and 12-14 remain pending and under examination.

In the Office Action, the Examiner took the following actions:

- (a) objected to claims 4, 8-11, and 13 under 37 C.F.R. § 1.75(c) as being in improper form due to multiple dependencies;
- (b) rejected claims 1-5, 8, 9, and 11-14 under 35 U.S.C. § 102(b) as being anticipated by WO 03/099944 (translated as U.S. Pat. App. Pub. No. 2005/0113485) to Yokoi et al. ("Yokoi");
- (c) rejected claims 1-5, 8, 9, 13, and 14 under 35 U.S.C. § 102(b) as being anticipated by EP 268 938 to Kadokura et al. ("Kadokura");
- (d) rejected claims 7 and 10 under 35 U.S.C. § 103(a) as being obvious over Kadokura;
- (e) rejected claim 6 under 35 U.S.C. § 103(a) as being obvious over Kadokura in view of WO 01/43714 to Reinehr et al. ("Reinehr"); and
- (f) rejected claims 11 and 12 under 35 U.S.C. § 103(a) as being obvious over Kadokura in view of U.S. Patent No. 7,101,536 to Mongiat et al. ("Mongiat").

II. Foreign Priority Under 35 U.S.C. § 119

The Examiner asserts that Applicants have failed to comply with the conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 119(b) by not providing an English language translation of Japanese Patent Application JP 2003-286827. See Office Action at page 3. Therefore, the Examiner seems to be relying on a priority date of August 5, 2004 (the PCT filing date) for the instant application.

To perfect priority under 35 U.S.C. § 119, Applicants enclose with this Amendment a certified English language translation of Japanese Patent Application JP 2003-286827, which was filed on August 5, 2003. Accordingly, Applicants have satisfied the requirements of 35 U.S.C. § 119, and perfected the priority date of August 5, 2003, for the present application.

III. Objection Under 37 C.F.R. § 1.75(c)

The Examiner objected to claims 4, 8-11, and 13 under 37 C.F.R. § 1.75(c) as being in improper form due to multiple dependencies. As noted above, Applicants have amended claims 3, 4, 8-10, and 13 to modify the claims' dependencies such that they are no longer dependent on multiple claims. Claim 11 has been cancelled. Applicants, therefore, respectfully request withdrawal of the objection to claims 4, 8-11, and 13.

IV. Rejections Under 35 U.S.C. § 102(b)

A. Claims 1-5, 8, 9, and 11-14 over Yokoi

The Examiner rejected claims 1-5, 8, 9, and 11-14 under 35 U.S.C. § 102(b) as being anticipated by Yokoi. Applicants note that claim 11 is cancelled by the amendment submitted herein and Applicants respectfully traverse the rejection of claims 1-5, 8, 9, and 12-14, to the extent it is applicable to the claims as amended herein.

Applicants submit that Yokoi is not prior art to the present application. Yokoi was published on December 4, 2003. As set forth above, Applicants have perfected their priority claim in the present application to Japanese Patent Application JP 2003-286827, filed August 5, 2003, which precedes the publication date of Yokoi. Therefore, Yokoi is not prior art to the present application. For the Examiner's convenience, Applicants point out in the following Table 1 specific written description support in JP 2003-286827, which is representative of the support contained therein, for each of rejected claims 1-5, 8, 9, and 12-14.

Table 1.

Pending Claim	Exemplary supporting in JP 2003-286827
1	Claim 1 and paragraph [0007]
2	Claim 2 and paragraph [0009]
3	Claim 3 and paragraph [0008]
4	Claim 4 and paragraph [0012]
5	Claim 5 and paragraph [0013]
8	Claim 8 and paragraph [0009]
9	Claim 9 and paragraph [0009]
12	Claim 12 and paragraph [0023]
13	Claim 13 and paragraph [0026]
14	Claim 14 and paragraphs [0006] and [0007]

Therefore, Applicants submit that the rejection is legally improper and respectfully request withdrawal of the rejection of claims 1-5, 8, 9, and 12-14.

B. Claims 1-5, 8, 9, 13 and 14 over Kadokura

The Examiner rejected claims 1-5, 8, 9, 13, and 14 under 35 U.S.C. § 102(b) as being anticipated by Kadokura. The Examiner asserted that Kadokura teaches cosmetic compositions comprising a lamina comprising a matrix substance (e.g.,

silicone dioxide) and a finely divided metal or metal compound dispersed therein (e.g., titanium dioxide, zinc oxide, and silver powder), wherein the lamina have an aspect ratio of 3-100. *See* Office Action at 3. From this, the Examiner concluded that Kadokura teaches each and every aspect of the present invention. *See id.* Applicants respectfully disagree and traverse this rejection to the extent it is applicable to the amended claims.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131 (emphasis added).

In the present case, Kadokura does not teach all the elements of the claimed invention. More specifically, in the present invention, the silicon based particles are “porous” and the optically active substance is “incorporated into said porous particles.” *See e.g.*, claim 1. In contrast, Kadokura discloses “a lamina comprising a laminar substance as a matrix and a finely divided metal or metal compound dispersed therein.” Kadokura, p. 2, lines 42-43. Kadokura does not teach porous particles, let alone the incorporation of an optically active substance into said particles.

Moreover, the Examiner conceded that Kadokura does not teach the spherical powder of claims 11 and 12. *See* Office Action at 5. As discussed above, claim 1 has been amended to incorporate the subject matter of now-cancelled claim 11, and claims 2-5, 8, 9, and 13 depend thereon. Thus, Kadokura does not teach a spherical powder, let alone a spherical powder in combination with the other elements of the pending claims in a cosmetic composition.

Therefore, for at least these reasons, Kadokura does not disclose all elements of the present invention, and Applicants respectfully request that the rejection of claims 1-5, 8, 9, 13, and 14 be withdrawn.

V. Claim Rejections Under 35 U.S.C. § 103(a)

A. Claims 7 and 10 over Kadokura

The Examiner rejected claims 7 and 10 under 35 U.S.C. § 103(a) as being obvious in view of Kadokura. The Examiner alleged that, in addition to teaching cosmetic compositions comprising a lamina comprising a matrix substance (e.g., silicon dioxide) and a finely divided metal or metal compound dispersed therein (e.g., titanium dioxide, zinc oxide, and silver powder), wherein the lamina have an aspect ratio of 3-100, Kadokura also teaches “nanoparticles of metal or metal compounds, such as silver powder, titanium dioxide and other substance[s] dispersed within the matrix particles.” Office Action at 3-4. While the Examiner conceded that Kadokura does not teach the combination of silver particles and titanium dioxide particles of claim 7, she proposed that such a combination would be within the skill of the ordinary practitioner. *See id.* at 4. Likewise, the Examiner conceded that Kodokura does not teach the oil absorbability of claim 10 but proposes that it would have been obvious to the skilled artisan to adjust absorbability. *See id.* Applicants disagree and respectfully traverse the rejection of claims 7 and 10.

In making a rejection under 35 U.S.C. § 103, the Examiner “bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *See* M.P.E.P. § 2142. In its decision in *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q. 2d 1385 (2007), the Supreme Court confirmed that the “framework for

applying the statutory language of §103" was still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). Under *Graham*, there are four factors for consideration when determining whether an invention is obvious:

- (1) the scope and content of the prior art;
- (2) the differences between the prior art and the claims at issue;
- (3) the level of ordinary skill in the art; and
- (4) secondary considerations.

383 U.S. at 17, 148 U.S.P.Q. at 467. However, the Court indicated that there is no necessary inconsistency between the idea underlying the teaching, suggestion, or motivation ("TSM") test and the *Graham* analysis. *KSR*, 127 S. Ct. at 1741, 82 U.S.P.Q. 2d at 1389. As long as the TSM test is not applied as a "rigid and mandatory" formula, the test can provide "helpful insight" to an obviousness inquiry. *Id.*

In the present case, claims 7 and 10 depend from independent claim 1. As set forth above, Kadokura does not teach all the elements of independent claim 1, and the Examiner did not set forth any additional evidence in the present rejection to cure those deficiencies. Although the Examiner alleged that "the particles of Kadokura et al. are porous," Office Action at 4, the Examiner did not provide any citation to the publication in support of this allegation and, as discussed above, Kadokura does not disclose said porous particles. While Kadokura discloses numerous properties of the lamina taught therein, including particle diameter, thickness, and ability to screen ultraviolet rays, it does not teach that the lamina are porous. Thus, the claims are not rendered obvious by Kadokura for at least those reasons.

Moreover, the Examiner has conceded that Kadokura does not teach the additional limitations of claims 7 and 10, and the Examiner has failed to provide any explicit reason why one of ordinary skill in the art would modify the compositions of Kadokura to arrive at the presently claimed invention as recited in claims 7 and 10. The Examiner merely stated that one would be motivated by the desire to obtain a composition with the properties taught in the present invention, such as a matte appearance and UV-screening. Such hindsight analysis is improper. Thus, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness.

Additionally, even if the Examiner had established a *prima facie* case of obviousness, which she has not, Applicants submit comparative data showing that the claimed invention possesses unexpectedly improved properties or properties that the prior art does not have, thereby rebutting any such *prima facie* case. *See* M.P.E.P. § 716.02(a).

Applicants have conducted experiments demonstrating the unexpected superiority of the claimed cosmetic composition. In the following experiments, powder formulations were prepared as Example 2 and Comparative Examples 3 and 4.

	Ex. 2	Comp. Ex. 3	Comparative example 4
Talc	33.6	33.6	33.6
Sericite	29.8	29.8	34.8
Mica	4.2	4.2	4.2
Titanium oxide	6.8	6.8	6.8
Iron oxide	1.87	1.87	1.87
Zinc stearate	0.85	0.85	0.85
Liquid paraffin	3.4	3.4	3.4
Phenyl Trimethicone	4.25	4.25	4.25
Preservatives	qs	qs	qs
Sunsphere H51 ³	5	5	0
PTSG 30A Flake	10	-	10
Godball SQE 10C	-	10	

³ silica porous sphere manufactured by Asahi Glass

Example 2 included "Sunsphere H51" brand porous silica spheres and "PTSG 30A Flake," porous glass flakes containing titanium oxide. Comparative Example 3 contained Sunsphere particles but no PTSG flakes. Comparative Example 4 contained PTSG flakes but no Sunsphere particles. The powder formulation of Comparative Example 3 was very difficult to press and exhibited cracking and poor mechanical resistance. Friction coefficients were measured using a friction meter instrument from KATOTECH. Friction coefficients relate to the ease of spreadability of the formulation on the skin. The coefficients were determined to be 0.72 for Example 2 and 0.80 for Example 4. Example 2, which contained both Sunsphere silica spheres and PTSG titanium-containing flakes displayed very good adhesion and spreadability on skin, with a natural finish and a long lasting effect of making fine facial lines and wrinkles difficult to see.

In the following experiments, liquid formulations were prepared as Examples 4 and 5 and Comparative Examples 5 and 6.

	Example 4	Example 5	Comp. example 5	Comp. example 6
Phase I				
Cetyltrimethicone copolyol/polyglyceryl-4 isostearate/hexyl laurate	8.6	8.6	8.6	8.6
Dimethicone	5.2	5.2	5.2	5.2
Cyclomethicone	5.5	5.5	5.5	5.5
Isododecane	3.0	3.0	3.0	3.0
Isostearyl Neopentanoate	0.9	0.9	0.9	0.9
Bentone gel	8.6	8.6	8.6	8.6
Phase II				
Water	46.5	46.5	46.5	46.5
Butylene glycol	6.0	6.0	6.0	6.0
Magnesium sulfate	0.9	0.9	0.9	0.9
Preservatives	qs	qs	qs	qs
Phase III				
PTSG 30A Flake	5	5	5	5
Sunsphere H51 (Asahi Glass)	2			
Plastic powder D400 (Toshiba Pigment)	2			
Covabead LH-85 (LCW)		4		
Mica Concord 1000 (Sciama)			4	
Ceridust 9205F (Clariant)				4

In each Experiment and Comparative Experiment, Phase I and II were mixed separately, then Phase II was added to Phase I via a conventional homogenizer. Phase III was then mixed into the emulsion of Phases I and II. Experiment 4 contained PTSG flakes and Sunsphere particles. Experiment 5 contained PTSG flakes and "Covabead LH-85" brand PMMA spherical powder. Comparative Examples 5 and 6 each contained PTSG flakes, but Comparative Example 5 contained "Mica Concord 1000" brand Mica particles, and Comparative Example 6 contained "Ceridust 9205F" brand wax powder.

Haze (based on the percentage of diffuse transmitted light) and total transmission were measured using a NDH 2000 Hazemeter from Nippon Denshoku. All measurements were carried out on a 20 μm thin film after 10 minutes of drying at 37 °C using SPF quartz cell obtained from JASCO (Nihon Bunkou). Examples 4 and 5 displayed 100 percent transmission and haze measurements of 73 and 85 percent, respectively. Comparative Examples 5 and 6 displayed 99 and 100 percent transmission, respectively, but had haze measurements of 56 and 58 percent, respectively. Thus, it is evident that the compositions of Examples 4 and 5, which are those of the invention, possess superior haze value and diffuse transmitted light, combined with very good transparency.

Therefore, as shown by the comparison of Examples 2, 4, and 5 and Comparative Examples 3-6, Applicants' inventive compositions exhibit superior results.

For at least the foregoing reasons, Applicants submit that the Examiner failed to establish a *prima facie* case of obviousness based on Kadokura, particularly in view of the present amendments. Moreover, even if the Examiner established a *prima facie* case, Applicants presented sufficient evidence to rebut any *prima facie* showing. Accordingly, Applicants submit that the rejection of claims 7 and 10 is improper and should be withdrawn.

B. Claim 6 over Kadokura in View of Reinehr

The Examiner rejected claim 6 under 35 U.S.C. § 103(a) as being obvious over Kadokura in view of Reinehr. As set forth above, the Examiner alleged that Kadokura teaches cosmetic compositions comprising a lamina comprising a matrix substance (e.g., silicon dioxide) and a finely divided metal or metal compound dispersed therein

(e.g., titanium dioxide, zinc oxide, and silver powder), wherein the lamina have an aspect ratio of 3-100, but the Examiner conceded that Kadokura does not teach the use of fluorescent substances, as in pending claim 6. *See* Office Action at 3 and 5. The Examiner relied on Reinehr to cure this deficiency. *See id.* Specifically, the Examiner alleged that "Reinehr et al. teach using fluorescent substances of the instant claim in UV protecting skin care compositions," and one would be motivated to use them in the matrices of Kadokura by the desire to obtain UV-protection and skin lightening effects. *Id.* at 5. Applicants disagree and respectfully traverse the rejection of claim 6.

In the present case, claim 6 depends from independent claim 1. As set forth above, Kadokura does not teach all the elements of amended independent claim 1, and the Examiner did not set forth any additional evidence from Reinehr or any other source in the present rejection to cure those deficiencies. Thus, the claims are not rendered obvious by Kadokura in view of Reinehr for at least the reasons set forth above.

Moreover, the Examiner has conceded that Kadokura does not teach the fluorescent substances of claim 6, *see* Office Action at 5, and the Examiner has failed to provide any explicit reason why one of ordinary skill in the art would use the fluorescent substances of Reinehr in the compositions of Kadokura to arrive at the presently claimed invention as recited in claim 6. The Examiner merely alleged that one would be motivated by the desire to obtain a UV-protection and skin-lightening effects as taught in Reinehr. *See id.* However, Kadokura already teaches that the compositions disclosed therein may be used as UV-screeners. *See e.g.*, p. 2, lines 50-52. Therefore, one would not be motivated to make the compositions of Kadokura UV-screeners as the Examiner proposes, as they may already possess that property. Thus, absent such

teaching or motivation, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness and, therefore, request that the rejection of claim 6 be withdrawn.

C. Claims 11 and 12 over Kadokura in View of Mongiat

The Examiner rejected claims 11 and 12 under 35 U.S.C. § 103(a) as being obvious over Kadokura in view of Mongiat. As set forth above, the Examiner alleged that Kadokura teaches cosmetic compositions comprising a lamina comprising a matrix substance (e.g., silicon dioxide) and a finely divided metal or metal compound dispersed therein (e.g., titanium dioxide, zinc oxide, and silver powder), wherein the lamina have an aspect ratio of 3-100, but the Examiner conceded that Kadokura does not teach the spherical powder of claims 11 and 12. *See* Office Action at 3 and 5. The Examiner relied on Mongiat to cure this deficiency. *See id.* at 5-6. Specifically, the Examiner alleged that "Mongiat et al. teach using spherical powders of the instant claims as SPF enhancers in UV protective compositions," and one would be motivated to use them in the matrices of Kadokura by the desire to obtain better UV-protection and improve the skin feel and the mattifying properties of the composition. *Id.* As noted above, claim 11 is now cancelled, and Applicants respectfully traverse the rejection of claim 12 for at least the reasons set forth below.

In the present case, claim 12 depends from independent claim 1. As set forth above, Kadokura does not teach all the elements of amended independent claim 1, and the Examiner did not set forth any additional evidence in Mongiat or any other source in the present rejection to cure those deficiencies. Thus, the claims are not rendered obvious by Kadokura in view of Mongiat for at least the reasons set forth above.

Moreover, the Examiner has conceded that Kadokura does not teach the spherical powders of amended claims 1 and 12, and the Examiner has failed to provide any explicit reason why one of ordinary skill in the art would use the spherical powders of Mongiat in the compositions of Kadokura to arrive at the presently claimed invention as recited in claim 12. The Examiner merely stated that one would be motivated by the desire to obtain properties disclosed in Mongiat. However, Kadokura already teaches that the compositions disclosed therein may be used as UV-screeners and to impart a good feeling in use. *See e.g.*, p. 2, lines 39-40 and 50-52. Therefore, one would not be motivated to use the spherical powders of Mongiat in the compositions of Kadokura as the Examiner proposes, as the Kadokura compositions may already possess the desired properties. Thus, absent any teaching or motivation to combine the references, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness and, therefore, request the withdrawal of the rejection.

VI. **Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 29, 2008

By: /Courtney B. Meeker/
Courtney B. Meeker
Reg. No. 56,821

Attachments:

Exhibit A: Certified English Language Translation of Japanese Patent
Application JP 2003-286827.

Exhibit A

Certified English Language Translation of
Japanese Patent Application JP 2003-286827